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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,471	09/10/2003	Jan-Ove Palmberg	06730.0056.NPUS00	4947
28694	7590	11/08/2006	EXAMINER	
NOVAK DRUCE & QUIGG, LLP 1300 EYE STREET NW 400 EAST TOWER WASHINGTON, DC 20005			LUM VANNUCCI, LEE SIN YEE	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,471

Applicant(s)

PALMBERG ET AL.

Examiner

Lee Lum

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) all is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An Amendment was filed 9/14/06 in which Claims 35-46 were cancelled, and Claims 47-61 added.

2. Claims 48, 53, 55 are objected to because "cam" should be preceded by "a" instead of "the".

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the independent Claims, "cam" does not correspond to the element in the Spec, p15-16, described as "the electric motor may rotate an eccentric axis 50, e.g., an oval...or rectangular axis or similar" (emphasis added), but is actually a broader term - see definition in paragraph 5. This constitutes new matter.

(The Examiner apologizes for overlooking this issue)

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

All Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent **Claims 47, 48, 53, 55**, the following issues exist, rendering the invention unclear:

- a. "[W]herein one valve member is rotatably and/or axially displaced with respect to a shaft" (emphasis added),

does not correspond to respective and subsequent language in the same Claim of

"wherein the cam...rotatably [engages] with a guide portion...on the valve member for an axial displacement" (emphasis added),

because the latter specifies one type of displacement, whereas the former allows either or both types of "displacements".

- b. Conflicting language - "one valve member", "valve member", "at least one member" - where at least two of the above are used in each independent Claim, are unclear because it is unknown if the same "member" is being referred, or another member, or otherwise.

- c. The language describing the operation of the "valve" - "to be actuated", and "to be dynamically further actuated", the latter recited twice in the same Claim - are unclear because one reasonable interpretation is that the valve is actuated by three means/operations, whereas it appears to be actuated by two means (via a motor, and a "control mechanism").

In all instances, amendment is required to render an accurate description of the invention.

(The Examiner apologizes for overlooking these important issues)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood, **Claims 47-61** are rejected under 35 U.S.C. 102(b) as being anticipated by Kohata et al 5511630.

As best understood, Kohata discloses a hydraulic power steering apparatus comprising Valve V1 to be actuated on an applied torque (via steering wheel 3) for altering a pressure of fluid to be received by the power steering system (fig 1),

The valve including first member 25, and second member 32, *as best understood*,

Wherein the valve is actuated by control mechanism U, depending on external vehicle input parameters via sensors 14-17 (c3, first paragraph), and,

Is further actuated by electromechanical displacement of second member 32, by motor 18, this second member being axially displaced with respect to shaft 26, *as best understood*,

The motor actuating cam* 33 engaging guide portions/teeth on the second member, *as best understood*.

* "Cam" is defined as "a rotating or sliding piece in a mechanical linkage used esp. in transforming rotary motion into linear motion", Merriam-Webster's Collegiate Dictionary, 10th Ed. Here, Kohata clearly discloses this element 33.

6. RESPONSE TO REMARKS

Upon reconsideration, Examiner provides 112/ 1st and 2nd rejections, which should have been raised in the very first Office Action. ***She sincerely apologizes for the inconvenience.*** Amendment is required to render a clear and accurate description of the invention. Therefore, due to severe clarity issues, Kohata arguably discloses all limitations.

7. Communication with USPTO/Examiner

Any inquiry concerning this communication, or others, should be directed to Ms. Lum at 571 272 6649, M-F, 9-5. If attempts to reach the examiner are unsuccessful, her supervisor, Ms. Lesley Morris is at 571 272-6651. Our fax number is 571 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications: private PAIR only, for published applications: private or public PAIR. For more information re PAIR: <http://pair-direct.uspto.gov>. Questions re private PAIR: contact the Electronic Business Center (EBC) at 866 217-9197.

Ms. Lee S. Lum
Examiner
11/7/06

